UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,702	07/17/2003	Steven P. Anonsen	M61.12-0553	1519

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EXAMINER
FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/621,702	ANONSEN ET AL.
	Examiner	Art Unit
	JEAN B. FLEURANTIN	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 11-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 11-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 January 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This is in response to the election requirement filed on 03/20/06, in which claims 1 and 11-17

elected.

2.   Claims 1 and 11-17 are presented for examination.

Drawings

3.   The Examiner accepts the drawings.

Specification

4.   The description portion of this application contains a computer program listing consisting of more

than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing of more

than three hundred lines <u>must</u> be submitted as a computer program listing appendix on compact disc

conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the

specification (see 37 CFR 1.77(b)(5)). Accordingly, applicant is required to cancel the computer program

listing appearing in the specification on pages 1-165, file a computer program listing appendix on compact

disc in compliance with 37 CFR 1.96(c) and insert an appropriate reference to the newly added computer

program listing appendix on compact disc at the beginning of the specification.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 11-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1,

As set forth in MPEP 2106 (IV)(B)(2)(a):

Products may be either machines, manufactures, or compositions of matter.
A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

Claim 1, in view of the above cited MPEP section is not statutory, because "an application programming interface exposing an AdhocQueryCriteria method to specify a query of data in a relational database in terms of entity properties and fields" does not produce any useful and tangible result.

As per claim 1,

As set forth in MPEP 2106 (IV) (B) (1):

"an application programming interface exposing an AdhocQueryCriteria method to specify a query of data in a relational database in terms of entity properties and fields" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material". In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F3d at 1360, 31 USPQ2d. See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459

In particular, the claimed subject matter of claims 1 and 11 are a non-statutory software, e.g., "an application programming interface exposing an AdhocQueryCriteria method to specify a query of data in a relational database in terms of entity properties and fields," comprising "an entityAliasList parameter; a JoinList parameter; a selectList parameter; a whereExpression parameter; and an orderBylist parameter". Instead of a physical or logical relationship description among the "an application programming interface exposing an AdhocQueryCriteria method to specify a query of data in a relational database in terms of entity properties and fields", the limitations are directed to descriptive material per se: "an application programming interface exposing an AdhocQueryCriteria method to specify a query of data in a relational database in terms of entity properties and fields," comprising "an entityAliasList parameter; a JoinList parameter; a selectList parameter; a whereExpression parameter; and an orderBylist parameter."

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102
> of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art
> to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 1 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

"Understanding SQL" Martin Gruber - 1990, pages 80-85, 88-94 and 410-415, ("Gruber") in view of U.S.

Pat. No. 6,484,180 issued to Lyons et al., ("Lyons").

As per claim 1, Gruber discloses "to specify a query of data in a relational database in terms of

entity properties and fields" (i.e., specifying a query, inserting each row into table name; see page 413,

last paragraph Syntax), "the method receiving a plurality of parameters to specify the query" (i.e., a query

specifying, inserting rows into table name; see page 413, last paragraph Syntax), comprising:

"an entityAliasList parameter" (see page);

"a JoinList parameter" (i.e., join tables; see Fig. 8.1 and page 89, the entire paragraph 2 and page

415, paragraph 1, line 3);

"a selectList parameter" (see page 414, last paragraph, lines 1-2);

"a whereExpression parameter" (see page 415, paragraph 1, line 2); and

"an orderBylist parameter" (see page 415, paragraph 1, line 5). Gruber fails to explicitly disclose

an application programming interface exposing an adhocQueryCriteria. However, Lyons discloses an

application programming interface exposing an adhocQueryCriteria (see Lyons col. 9, lines 12-19). It

would have been obvious to a person of ordinary skill in the art at the time the invention was made to

modify the teachings of Gruber with an application programming interface exposing an

adhocQueryCriteria as disclosed by Lyons (see Lyons col. 8, lines 30-62 and col. 10, lines 28-31). Such a

modification would allow the teachings of Gruber to provide a mechanism that achieves the benefits of

both the relational model and the object oriented model (see Lyons col. 5, lines 11-13). Thereby,

providing a mechanism to deliver data from a relational data store to a user interface (see col. 6, lines 17-18).

As per claim 11, the limitations of claim 11 are rejected in the analysis of claim 1, and this claim is rejected on that basis.

As per claims 12 and 16, Gruber further discloses "an orderBylist parameter" (see Fig. 7.4 and page 80, paragraph 2).

As per claims 13, 15 and 17, Gruber further discloses "a joinList parameter" (i.e., join tables; see Fig. 8.1 and page 89, the entire paragraph 2 and page 415, paragraph 1, line 3).

As per claim 14, the limitations of claim 14 are rejected in the analysis of claim 1, and this claim is rejected on that basis.

Prior Art

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,496,833 issued to Goldberg et al., relates to a system for generating the query objects.

CONTACT INFORMATION

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

April 12, 2006

SHAHID ALAM
PRIMARY EXAMINER